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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,841	12/07/2005	Georges Zagdoun	281280US2PCT	1850

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EXAMINER

NGO, HUNG V

ART UNIT PAPER NUMBER

2831

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/559,841

Applicant(s)

ZAGDOUN, GEORGES

Examiner

Hung V. Ngo

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 15-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12-07-05</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claims 15, lines 3, 6, 8, 9, 13, 17, the repeated use of the conjunction "or" and alternative terms renders the subject matter of claim 15 unclear.

Claim 15, line 7 "it being possible" is unclear.

Claim 15, line 9 "possibly being optionally joined" is unclear.

Claim 15, line 14, "when present" is unclear

Claim 17, line 3 "when present" is unclear

Claims 17, 18, line 7, "and/or" is unclear.

Claim 19, line 6 "and/or" is unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 18-25, 27, 28 as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Tone et al (EP1196018).

Tone et al disclose an electromagnetic shielding structure comprising:

a first transparent substrate (5);

a conductive element (14) deposited on a transparent plastic backing sheet (14, PET);

a transparent plastic tie sheet (11), which ensures that the conductive element (14) is attached to the substrate (5) by joining the supporting sheet (14) to the tie sheet (11) on the side opposite the conductive element;

a transparent covering sheet (11), which is attached to the surface of the supporting sheet (14) opposite the one to which the tie sheet (11) is attached and on the conductive element side; electrical connecting means (electrode 3) intended to be connected to the conductive element (14) for grounding the conductive element; wherein at least one of its sides, the covering sheet (11) is set back towards the inside of the structure relative to the corresponding free edge of the transparent substrate (5),

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thereby leaving an exposed portion on at least one of the surfaces of the conductive element; the connecting means (3) are brought into contact with connected to said exposed portion (Fig.3)(re claims 15, 18, 19).

Re claim 20 describes a structure wherein the conductive element is a silver-based metal layer (column 15, lines 38 to 42) .

Re claim 21, a structure consisting of a grid of conductive wires made of copper (column 15, lines 7 to 12).

Re claim 22, conductive gasket (17)(in figure 7) consist of a flat conductor, such as a bus-bar or a strip of conductive foam.

Re claim 23, 28 see Fig 8

Re claims 24, 27, column 14, lines 45 to 52, describes a structure in which, in a frame-like arrangement, the exposed portion corresponds to the entire periphery of one of the surfaces of the conductive element.

Re claim 25, wherein the backing sheet made of PET, plastic (column 15, lines 7 to 9)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16, 17, 26 as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tone et al.

The teaching as discussed above includes the covering sheet (11) is set back towards the inside of the structure relative to the corresponding free edge of the transparent substrate (5), but does not disclose the tie sheet, the backing sheet and the additional sheet being set back towards the inside of the structure relative to the corresponding to a free edge of the substrate, the tie sheet, the additional sheet made of plastic.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to rearrange the location of the set back portion relative to a free edge of the substrate of Tone et al for the purpose of exposing the portion of the conductive element, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tie sheet and the additional sheet of Tone et al by employing plastic or other material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung V. Ngo whose telephone number is (571) 272-1979. The examiner can normally be reached on Monday to Thursday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A. Reichard can be reached on (571) 272-2800 EXT 31. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HVN
09-20-06

Hung V. Ngo

**HUNG V. NGO
PRIMARY EXAMINER**